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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,656	02/11/2004	Rafail Zubok	532/2x3 (F-280 Cont II)	3382
51640	7590	05/19/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER

3738

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/776,656	ZUBOK ET AL.	
	Examiner	Art Unit	
	Cheryl Miller	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/6/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 3, 2005 has been entered. It is noted to the applicant that although the IDS has been entered as the submission, no other papers were found attached to the RCE. The claims were finally rejected, however, the applicant did not respond to any of the previous rejections. The previous rejection has been maintained.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-5 and 15-19 of copending Application No. 10/382,702, and claims 1 and 3-9 of copending Application No.**

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10/776,434, and claims 1-17 of copending Application No. 10/776,650, and claims 1-20 of copending Application No. 10/776,651, and claims 1, 3, 5-13, 15, and 16 of copending Application No. 10/776,471. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are either merely broader than the co-pending application claims, or simply use different terminology to describe the features of the invention, for instance saddle and toroidal both describing a surface with concave and convex arcs, and also, different radii and non-congruent both describing a similar surface. The current application claims 1-18 are merely broader or obvious equivalents of the co-pending application claims. Once applicant has received a patent for a species or a more specific embodiment, and is not entitled to a patent for the generic or broader invention. The more specific "anticipates" the broader. The patented claim "anticipates" the application claim. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shelokov (US 6,039,763, cited in previous office action). Shelokov discloses a first member (1) having a saddle shaped articulation surface (seen in fig. 1a-1c; saddle being broadly interpreted by the examiner to be a ridge extending between two peaks) having a single concave arc extending between two ends (concave arc seen in fig. 1b, between 4 and 5; assuming the implant is inserted sideways, that is considering fig. 1b to be a lateral view) and a single convex arc (3) extending between lateral ends (seen in fig. 1a; assuming again, that Shelokov implant is inserted sideways), and a second member (10; seen in fig. 2a-2c) having a saddle shaped articulation surface having a single convex arc (near reference numeral 18, in fig. 2b) extending between two ends (assuming Shelokov's implants are implanted sideways, 18, extends between leading and trailing ends; that is, the examiner is interpreting P14 to be the leading end and P13 to be the trailing end, in fig. 2b), and a single concave arc (12; fig. 2a) extending between first and second lateral ends, wherein the saddle shaped articulation surfaces are shaped to engage one another (fig. 3a-4b), and allow rotation through a range of angles (col. 4, lines 46-52; col. 5, lines 55-60), and wherein the concave arcs are larger than the convex arcs (col. 3, lines 6-10; col. 5, lines 60-62; col. 8, lines 37-42).

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferree (US 6,706,068 B2). Ferree discloses a first member (upper plate seen in fig. 7, 8, 10, 12) having a saddle shaped articulation surface (seen in fig. 10; saddle being broadly interpreted by the examiner to be a ridge extending between two peaks), that is toroidal (col. 3, lines 52-56) having a single concave arc (only one *concave* arc exists on the upper plate, seen in fig. 7 on the right side) extending between two ends and a single convex arc (convex arc on upper plate is seen in

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fig. 10; looking at the anterior or posterior side) extending between lateral sides, and a second member (lower plate seen in fig. 7, 8, 10, 12) having a saddle shaped articulation surface having a single convex arc (only one *convex* arc exists on the lower plate, seen in fig. 7, 8 on the right side) extending between two ends, and a single concave arc (concave arc seen on lower plate in fig. 10, looking at the anterior or posterior end) extending between first and second lateral sides, wherein the saddle shaped articulation surfaces are shaped to engage one another (fig. 7, 8, 10, 12), and allow rotation through a range of angles (some rotation exists, although limited, col. 3, lines 42-46), and wherein the concave arcs are larger than the convex arcs (col. 4, lines 1-11, 35-38).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over both Shelokov (US 6,039,763) and Ferree (US 6,706,068 B2) taken separately. Both Shelokov (col. 3, lines 6-10; col. 5, lines 60-62; col. 8, lines 37-42) and Ferree (col. 4, lines 1-11, 35-38) separately disclose saddle surfaces having concave arcs with large radii than the convex arc, however, neither Shelokov nor Ferree disclose specific dimensional relationships claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the range of dimensions claimed, since when the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER